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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,664	10/15/2001	Robert D. Herpst		3468

26009 7590 03/22/2005
ROGER M. RATHBUN
13 MARGARITA COURT
HILTON HEAD ISLAND, SC 29926

EXAMINER

ALEXANDER, LYLE

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,664

Applicant(s)

HERPST, ROBERT D.

Examiner

Lyle A Alexander

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2004 and 17 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,10-20,28,30-33,35-37 and 39-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,10-20,28,30-33,35-37 and 39-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. 3/17/05
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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In response to the 3/17/05 telephone interview, the Office agreed the Office action sent out 12/02/04 did not address the 9/17/04 amendments and remarks. As a remedy, the Office will send out this new non-final Office action that addresses the 9/17/04 amendments and remarks.

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-2,10,12,15-20,30-32,35,39,46-48 and 50-51 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Persky et al.

Persky et al. teach in columns 1-2 that it is known to use metal band saws to cut alkali-halide scintillator crystals. The taught saw has been read on the claimed sawing and the taught scintillator crystal has been read on the claimed "sample holder".

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 10-11,13-14,28, 32-33 and 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Persky et al.

Sée Persky et al. supra.

The art is silent to the claimed materials of construction of the glass, specifically the alkali halide such as potassium bromide/chloride and sodium chloride.

The court decided In re Leshin (125 USPQ 416) that selection of a material based upon its suitability of intended use would have been within the skill of the art in view of 35 USC 103.

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Alkali halide crystal materials comprising potassium bromide/chloride or sodium chloride are well known in the art and advantageous because of their low cost, excellent optical properties and hardness.

It would have been within the skill of the art to modify Persky et al. and use an alkali halide crystal materials comprising potassium bromide/chloride or sodium chloride to gain the above advantages and in view of Leshin because selection a material based upon its suitability of intended use.

Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Persky et al. in view of Marker et al. (4,855,110)

Sée Persky et al. supra.

Persky et al. is silent to the use of a carousel for containing the slide to interface with an analyzer.

Marker et al. teach the use of a carousel in an automated analyzer. The carousel has the advantages of providing immediate access to all of the samples, which enables “stat” analysis of an important sample. Automated analyzers have the additional advantages of reducing human error, lower labor costs and permit 24/7 operations.

It would have been within the skill of the art to modify Persky et al. in view of Marker et al. and use a carousel engaged with an automated analyzer to gain the above advantages.

Response to Arguments

Applicant's arguments filed 9/17/04 have been fully considered but they are not persuasive.

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Applicants state all of the independent claims have been amended to better define the invention that the holding substrate is formed by one or more specific mechanical steps of cleaving, cutting, etc. MPEP 2113 states the patentability of a product does not depend upon its method of production. See *In re Thorpe*, 777 F.2d 695,698,227 UPSQ 966. Once a product appearing to be substantially identical is found and a 35 USC 102/103 rejection made, the burden shifts to the Applicant to show an unobvious difference. Applicant's comments have not addressed the differences in the product made by the claimed mechanical steps.

Applicants state Persky teaches a sawing technique for cutting scintillator material that is used for IR spectrometers that is totally different from the method of the instant invention. As described above, the patentability of a product does not depend upon its method of production. The Office maintains this rejection is proper.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lyle A Alexander whose telephone number is 571-272-1254. The examiner can normally be reached on Monday, Wednesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lyle A Alexander
Primary Examiner
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A handwritten signature in black ink, appearing to be 'Lyle A. Alexander', written over the printed name.